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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,456	04/02/2004	Geoffrey B. Rhoads	P0965	1643
23735	7590	07/18/2006	EXAMINER	
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			LABAZE, EDWYN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/817,456

Applicant(s)

RHOADS, GEOFFREY B.

Examiner

EDWYN LABAZE

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 10, 11, 13-15, 18 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10, 11, 13-15, 18 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4272006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of IDS filed on 4/27/2006.
2. Receipt is acknowledged of amendments filed on 4/27/2006.
3. Claims 1-5, 10-11, 13-15, 18, 21-25 are presented for examination.
4. This application is a CON of 10/717,211 filed on 11/18/2003, which is a CON of 09/342,688 filed on 6/29/1999 now PAT 6,650,761, which is a CIP of 09/314,648 filed on 5/19/1999 now PAT 6,681,028 and claims benefits of 60/134,782 filed on 5/19/1999.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-4, 10, 15, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Durst Jr. et al. (US 2001/0011276).

Re claims 1 and 15: Durst Jr. et al. {hereinafter referred as “Durst”} discloses scanner enhanced remote control unit and system for automatically linking to on-line resources, which includes means of using a handheld appliance {herein interpreted as the remote control unit 10}, receiving machine-readable digital {herein bar code symbol 12} data from the poster {herein interpreted as the printed intelligent document 14}, the data being in addition to the visible information {herein Durst discloses transmission of the captured image or pre-processed data of the machine readable symbol 12 to the web-ready television 20} (paragraphs 37+, 43+); by reference to the machine-readable received from the poster 14, establishing a link to a remote computer (paragraphs 49+; 71-72; 118+).

Re claim 2: Durst teaches a system and method in which the appliance is a wireless device (see figs. # 1-2).

Re claim 3: Durst discloses a system and method in which the appliance comprises a computer {herein interpreted as having computer means through the control/recognition/decision logic 30} (see fig. # 3; paragraphs 86+).

Re claims 4, 13: Durst teaches a system and method in which the appliance comprises an optical sensor or optical character recognition (paragraphs 82-86).

Re claim 10: Durst discloses a system and method that further includes communicating {herein a transmit button 24 using IR technology} over a link to cause electronic content to be transferred (paragraph 44+).

Re claim 22: Durst teaches a system and method, wherein the digital data comprises first and second data fields, one of said fields serving to identify an internet address, and a second of

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said fields serving to convey identification data that can be passed to said internet address to elicit a response corresponding to said poster (paragraphs 50+).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 11, 13, 18, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durst et al. (US 2001/0011276) in view of Rhoads (U.S. 6,427,020).

The teachings of Durst et al. have been discussed above.

Durst et al. fails to specifically teach that the appliance includes an output device, and the method includes presenting information to a user based on data obtained from said remote computer using said output device, wherein the electronic content comprises a song, in which the poster is printed, and the printing includes a plural-bit code steganopaphically encoded therein.

Rhoads teaches methods and devices for recognizing banknotes and responding accordingly, which includes means of scanning a barcode having encoded watermarks (col.11, lines 1-67, also see claims 11, 18).

In view of Rhoads' teachings, it would have been obvious to an artisan of ordinary skilled in the art at the time the invention was made to employ into the teachings of Durst et al. an appliance with means of receiving information from a remote computer, wherein the appliance

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has a display, a speaker, and means of encoding watermark {in the form of a plural-bit code steganographically} in the barcode. Herein Durst teaches means of using a remote control with means of scanning and decoding a barcode and transmitting the encoded information to a remote system for linking/downloading an associated webpage. Similar technique is also known in the art using a portable phone or PDA with scanning/imaging capabilities and wireless technologies {such as a transceiver for transmitting/receiving to and from a remote system; as disclosed by Rhoads in col.13, lines 3+}, also wherein various information {such as music tracks used in advertisements for concerts, new CD release and the like; movie clip; passage of a book} can be encoded in the bar code and tailored in a SMS/Short Message Service system for providing a sample to a customer. Furthermore, such modification would be beneficial to both the vendor and the customer wherein sale agents need not to be present for promoting a product and the customer could have a preview of the product for sale, and wherein the watermark encoded in the barcode would provide an authentic feature thereby preventing counterfeited products. Moreover, such modification would have been an obvious extension as taught by Durst et al.

Response to Arguments

9. Applicant's arguments with respect to claims 1-5, 10-11, 13-15, 18, and 21-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Stern (U.S. 6,553,404) discloses digital system.

Nygren et al. (U.S. 6,871,780) teaches scalable distributed database system and method for linking codes to Internet information.

Kovesdi et al. (US 2003/0155413) teaches system and method for authoring and providing information relevant to a physical world.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

el

Edwyn Labaze
Patent Examiner
Art Unit 2876
July 7, 2006


JARED J. FUREMAN
PRIMARY EXAMINER